

1 SIDLEY AUSTIN LLP

JEFFREY M. OLSON (SBN 104074) *jolson@sidley.com*

2 MATTHEW S. JORGENSEN (SBN 229131) *mjorgenson@sidley.com*

3 555 W. Fifth Street, Suite 4000

Los Angeles, California 90013

(213) 896-6000 phone

4 (213) 896-6600 fax

5 Attorneys for Plaintiff

DEPUY SYNTHES PRODUCTS, LLC

6 Robert W. Dickerson (State Bar No. 89367) *dickersonr@dicksteinshapiro.com*

7 DICKSTEIN SHAPIRO LLP

2049 Century Park East, Suite 700

8 Los Angeles, California 90067

(310) 772-8300 phone

9 (310) 772-8317 fax

10 Attorneys for Defendant

11 SPINAL KINETICS, INC.

12
13 UNITED STATES DISTRICT COURT
14 NORTHERN DISTRICT OF CALIFORNIA
15 SAN JOSE DIVISION

16 DEPUY SYNTHES PRODUCTS, LLC,

17 Plaintiff,

18 v.

19 SPINAL KINETICS, INC.,

20 Defendant.

21
22 AND RELATED COUNTERCLAIMS
23

Case No. 4:13-CV-00875-RMW (PSG)

24 **STIPULATION AND []**
25 **ORDER TO STAY CASE PENDING**
26 **APPEAL OF RELATED CASE**
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1 On February 26, 2013, DePuy Synthes Products, LLC (“DSP”) filed its complaint in the
2 present case (“the *DSP* case”). Dkt. 1.

3 On March 15, 2013, the Court ordered the present case related to *Synthes USA, LLC (f/k/a*
4 *Synthes (U.S.A.) v. Spinal Kinetics, Inc.*, 5:09-CV-01201-RMW (“the *Synthes* case”). Dkt. 12. The
5 *Synthes* case involves allegations relating, *inter alia*, to the validity and/or invalidity of U.S. Patent
6 No. 7,429,270 (“the ‘270 patent”) and the infringement and/or non-infringement of the ‘270 patent
7 by Spinal Kinetics’ M6 implants. The *DSP* case also involves Spinal Kinetics’ M6 implants, and
8 includes allegations relating, *inter alia*, to the validity and/or invalidity and infringement and/or non-
9 infringement of U.S. Patent No. 8,382,838, which is a continuation of the ‘270 patent. DSP asserts
10 that both the ‘270 patent and the application maturing into the ‘838 patent were previously assigned
11 to Synthes USA, LLC; and that the plaintiff in the *DSP* case, DePuy Synthes Products, LLC, is
12 presently the assignee of both the ‘270 patent and the ‘838 patent. The *Synthes* case was tried to a
13 jury and final judgment was entered on April 23, 2012. *See* Dkt. 524 in the *Synthes* case. The
14 *Synthes* case is presently on appeal to the United States Court of Appeals for the Federal Circuit,
15 Appeal No. 2013-1047, -1059.

16 On April 22, 2013, Spinal Kinetics filed its “Second Corrected” answer and counterclaims.
17 Dkt. 17. Spinal Kinetics’ counterclaims include, *inter alia*, claims for declaratory judgment that the
18 ‘838 patent is invalid and not infringed and antitrust and other claims that Spinal Kinetics contends
19 are based at least in part on the outcome of the jury trial and judgment in the *Synthes* case, which is
20 now on appeal to the Federal Circuit.

21 DePuy Synthes Products, LLC’s response to Spinal Kinetics’ counterclaims is presently due
22 on May 13, 2013.

23 Because of the relatedness of these two actions, the potential impact on the *DSP* case of the
24 Federal Circuit’s decision in the *Synthes* case now on appeal, and to preserve the resources of the
25 parties and this Court,

1 **IT IS HEREBY STIPULATED AND AGREED**, by and between the parties, through their
2 undersigned counsel of record, and subject to the approval of this Court, that the present action is
3 stayed in all respects, and all current deadlines are vacated. Such stay shall be without prejudice to
4 the substantive rights of any party, and shall continue until the Federal Circuit's mandate in the
5 appeal of the *Synthes* case is issued, or until such other time as determined by the Court, including in
6 response to a motion filed by either party to lift or extend the stay.

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8 Agreed to and submitted by:

SIDLEY AUSTIN LLP

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11 Dated: May 6, 2013

By: /s/ Jeffrey M. Olson
Jeffrey M. Olson
Attorneys for Plaintiff
DEPUY SYNTHES PRODUCTS, LLC

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14 DICKSTEIN SHAPIRO LLP

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16 Dated: May 6, 2013

By: /s/ Robert W. Dickerson
Robert W. Dickerson
Attorneys for Defendant
SPINAL KINETICS, INC.

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23 **PURSUANT TO STIPULATION, IT IS SO ORDERED.**

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26 Dated: Í 8 8H, 2013


Honorable Ronald M. Whyte
United States District Judge